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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,944	12/04/2003	Yusuke Ichikawa	17295	7378
23389 7590 02/16/2010 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER YABUT, DIANE D				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
02/16/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/727,944

**Applicant(s)**

ICHIKAWA, YUSUKE

**Examiner**

DIANE YABUT

**Art Unit**

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

### **DETAILED ACTION**

This action is in response to applicant's request for reconsideration received on 11/04/2009.

#### ***Response to Arguments***

1. Applicant's arguments filed 11/04/2009 have been fully considered but they are not persuasive.
2. Applicant generally argues that forming the annular-shaped recesses after formation of the cutting tip portion, as recited in the claims, prevents a crack that would form in the annular-shaped recesses, and that Masatoshi does not teach this limitation. The claimed phrase "annular-shaped recesses formed after formation of the cutting tip portion" is being treated as a product by process limitation. As set forth in MPEP 2113, product by process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. MPEP 2113.
3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ouchi** (U.S. Patent No. **6,238,336**) in view of and **Masatoshi** (JP **11076254**) and **Hoyns** (U.S. Patent No. **5,759,154**).

Ouchi discloses an ultrasonic endoscope with a sheath **100** which is inserted into a treatment tool insertion channel **13** of the ultrasonic endoscope and a pipe-shaped needle tube **101** for being inserted into tissue within the body cavity through the sheath which includes a cutting tip portion formed in a sharp shape with a smaller cross-section in a tip-ward direction, the cutting tip portion being provided on a tip side of the needle tube (Figure 1, col. 4, lines 15-20).

Ouchi also discloses a tube portion formed in the shape of a tube at the rear end of the puncturing portion of needle **101**, and a tube-shaped portion formed as an extension of the tube portion (Figure 1, col. 4, lines 15-20).

Ouchi does not expressly disclose having a plurality of staggered-array annular-shaped recesses, formed after formation of the cutting tip portion, having flat surfaces on bottoms and sides thereof and provided from a back surface of the cutting tip portion near a tip of the needle tube to a predetermined range on a surface of a tip portion of the needle tube, which is an area excluding the cutting tip portion.

Masatoshi teaches an ultrasonic needle tube **1** with annular-shaped recesses **30** formed after formation of the cutting tip portion, located in an area excluding a cutting tip portion (Figures 4-5), the annular-shaped recess having flat surfaces on bottoms and sides with smoothly curving interfaces therebetween (Figure 6). It would have been obvious to one of ordinary skill in the art at the time of invention to provide annular-shaped recesses being formed at positions such that overlap of the recesses and the cutting-tip portion does not occur, as taught by Masatoshi, to Ouchi in order to project the positioning of the needle under an ultrasonic image clearly, safely, and reliably while preventing interference of the piercing function. In addition, it would have been obvious to one of ordinary skill in the art to provide annular-shaped recess having flat surfaces on bottoms and sides with smoothly curving interfaces therebetween in order to be projected clearly under an ultrasonic image, making it possible to carry out puncture safely and reliably.

Hoyns teaches an ultrasonic puncture needle with recesses being in a staggered-array (Figures 1A-2). It would have been obvious to one of ordinary skill in the art at the time of invention to provide recesses being in a staggered-array, as taught by Hoyns, to Ouchi in order to provide a stronger return signal of an incident ultrasound beam to the ultrasound array and a more specular reflection of an ultrasound beam at shallow angles of incidence (col. 3, lines 33-38).

***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIANE YABUT whose telephone number is (571)272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Diane Yabut/  
Examiner, Art Unit 3734

/Todd E Manahan/  
Supervisory Patent Examiner, Art Unit 3734